

REMARKS

In an Office Action mailed on June 29, 2004, claim 8 was rejected under 35 U.S.C. § 112; claims 6, 8-14, 25-30, 35-37 and 44-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Boutros; claims 15, 16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Pope; claims 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Pope and Volz; claims 21-24 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Volz; and claims 1-5, 42 and 43 were allowed. Claim 8 has been amended to overcome the § 112 rejection. The §§ 102 and 103 rejections are discussed below.

§ 102 Rejections of Claims 6, 8-14, 25-30, 35-37 and 44-48:

Independent claims 6, 11, 25, 28 and 35 have each been amended to recite that the slot connector housing assembly is mounted on a motherboard of a computer system. Such a feature is not disclosed in Boutros, as Boutros is directed to a modular plug connector for an Ethernet cable. Thus, not only does Boutros fail to disclose all of the limitations of amended independent claims 6, 11, 25, 28 and 35, the features that are recited in the amended claims are not even contemplated by Boutros' disclosure. Therefore, for at least this reason, withdrawal of the § 102 rejections of claims 6, 8-14, 25-30, 35-37 and 44-48 is requested.

Rejections of Claims 15-20:

The connector of independent claim 15 includes a housing that is formed from a material that has a thermal conductivity of at least approximately 0.27 W/m·K. Similarly, the method of independent claim 18 includes using a material having a thermal conductivity of at least approximately 0.27 W/m·K to form a housing for a slot connector.

As conceded by the Examiner, Boutros fails to disclose a material having the thermal conductivity as recited in independent claims 15 and 18. Therefore, the Examiner relies on the combination of Boutros with Pope to allegedly derive the missing claim limitations. However, a *prima facie* case of obviousness has not been set forth for either independent claim.

More specifically, a *prima facie* case of obviousness requires the Examiner to show where the prior art contains the alleged suggestion or motivation for the combination of

references to derive the claimed invention. *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143.

Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified Boutros in view of Pope's teaching to derive the claimed invention. Instead of showing where the prior art contains the alleged suggestion or motivation, the Examiner merely concludes a case of obviousness based on the hindsight gleaned from the current application. The Examiner contends that the modification only requires routine skill in the art. Office Action, 6. However, this is improper as rarely does the alleged general level of skill in the art provide the suggestion or motivation to reach an obviousness judgment. *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Thus, the Examiner fails to show why one skilled in the art would have modified a modular plug Ethernet connector, that dissipates a relatively small amount of thermal energy, with a material for a housing that has a thermal conductivity of at least 0.27 W/m·K. Without such a showing, a *prima facie* case of obviousness has not been set forth for either claim 15 or claim 18.

Claims 16, 17, 19 and 20 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103 rejections of claims 15-20 is requested.

Rejections of Claims 21-24 and 39-41:

The Examiner rejects both independent claims 21 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Volz. However, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Boutros' modular housing to have fins to conduct heat away from circuitry of a circuit board. In this manner, Boutros is directed to a relatively low-power modular Ethernet connector. Thus, nowhere in Volz or Boutros is there a suggestion or motivation for the modification of Boutros' connector to include fins to conduct heat away from Boutros' circuit board. As pointed out in the previous replies, Volz is directed to a heat sink assembly, not a slot connector housing assembly. Thus, Volz does not provide the necessary suggestion or motivation for the modification of Boutros in view of Volz to derive the claimed invention.

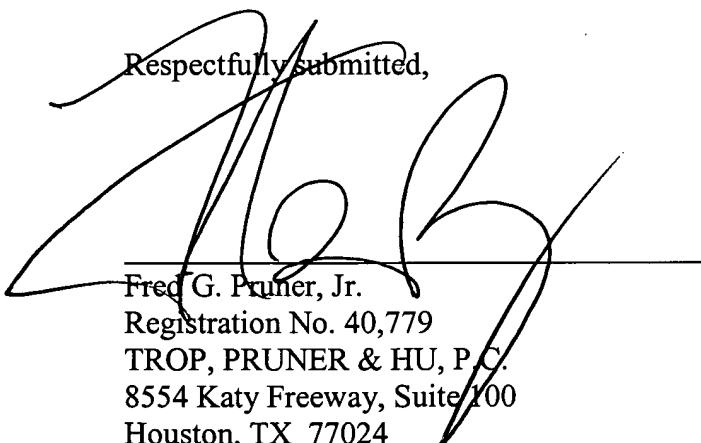
"Obviousness cannot be predicated on what is unknown.". *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Rather, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified or combined references to derive the claimed invention. The Examiner has failed to make this showing; and thus, for at least this reason, the Examiner fails to establish a *prima facie* case of obviousness for either independent claim 21 or 39.

Claims 22-24, 40 and 41 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103 rejections of claims 21-24 and 39-41 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102, 103 and 112 rejections and a favorable action in the form a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 20-1504 (ITL.0519US).

Date: July 14, 2004

Respectfully submitted,

Fred G. Pruner, Jr.
Registration No. 40,779
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]